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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/994,363	12/19/97	GARRISON	D 33500-00003

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LM71/0829

EXAMINER

ELMORE, R

ART UNIT

PAPER NUMBER

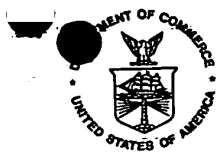
2759

DATE MAILED: 08/29/00

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**Commissioner of Patents and Trademarks**



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/994,363	12/19/97	GARRISON	D 33500-00003

LM12/0229  
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EXAMINER

ELMORE, R

ART UNIT	PAPER NUMBER
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2786

DATE MAILED: 02/29/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/994 363

Applicant(s)

GARRESON et al.

Examiner

R. Elmore

Group Art Unit

2764

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 12/2/99.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 111; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

### **Part III DETAILED ACTION**

#### ***Title***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is unclear as to how 'account ranging' relates to the claimed invention.

#### ***Specification***

2. The 'Cross-Reference to Related Application' Section needs to be updated.
3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Double Patenting***

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 11, 13-15, 19-31 and 35-50 of copending Application No. 09/010,193. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The claims of 09/010,193 covers the limitations of the present invention. They include the features of requests for making payment to a payee having a plurality of payment remittance centers with the requests including information identifying the payor account, ability to update the accounts, processing the account number at a single remittance center and properly directing payments.

Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-28 of copending Application No. 08/994,047. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The claims of 08/994,047 covers the limitations of the present invention. They include the features of requests for making payment to a payee having a plurality of payment remittance centers with the requests including information identifying the payor account with zip code type information being stored, the ability to update the accounts, processing the account number at a single remittance center and properly directing payments.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by **Chasek**.

Chasek teaches the invention as claimed (claim 1, 6, 11 and 16) including a system and method for a computer remittance payment procedures, the system and method comprising:

an interface for receiving a payor request to make payment to a payee having a plurality of payment remittance centers, the request including information identifying a payor account number with the payee is taught as a network system for buying, selling and collecting payment for in a computer network environment which uses PAC, personal account custodian, technology which uses data from the payer, payee, details of the transaction and security (Figures 3c-6 and col. 1, lines 41-51);

a processor for processing the account number to select a single remittance center of the plurality of remittance centers to which payment is to be made is taught as a VAC or vendor account custodian being equivalent to the remittance centers (col. 3, lines 15-41);

computer memory for storing the software necessary for the remittance payments to be processed within the network is taught as being internal to the account computer of Figure 5 and the buffer memory of Figure 6; and,

directing payment to a single remittance center is taught as determining the actual vendor of the service or product purchased (col. 3, line 42 to col. 4, lined 7).

As to claims 2, 7, 12 and 17, Chasek teaches the account number is processed to identify information of the account number which corresponds to a single remittance center is taught as the payee's account number (col. 3, lines 42-50).

As to claims 3, 8, 13 and 18, the reference inherently teaches the identified information of the account number includes one or more alphanumeric characters identifying a single remittance center as all identifying data must be in the form of alphanumeric characters within the computer system.

As to claims 4, 9, 14 and 19, Chasek teaches the information includes payor name and address data, a database which includes payee records, processing the information to produce a zip code for the payee and accessing the database to locate payee records corresponding to the zip code is taught as databases for storing information which identifies the payees, payors and additional members of the network (col. 7, line 10 to col. 8, line 33).

As to claims 5, 10, 15 and 20, Chasek teaches storing in a database includes alteration rules for each payee indicating a format in which the payee is to receive an account number and transforming the received account number into an altered account number according to the alteration rules is taught as being able to reprogram the PROMs and EEPROMs used in the system (col. 4, lines 8-41 and col. 5, lines 28-46).

***Claim Rejections - 35 USC § 103***

8. The rejections of claims 1-20 are ***maintained*** from the previous rejections.

***Response to Applicant's Remarks***

9. As to the remarks:

as to Tillery not teaching or suggesting payment processing but billing processing, the applicant is arguing limitations not claimed. The claims require data be processed for payment to

a remittance center. The claims are not detailed to include specifics as to how the actual payment is to be remitted. The claims never actually 'debit' the accounts.

As to there being a plurality of remittance centers, the Tillery reference gives details for one remittance center, however, a network is shown and would inherently include the ability to have additional remittance centers to the extent actually claimed.

As to the request for a reference to support the Official Notice taken in reference to account numbers being used for tracking purposes in the billing art, this request is not complied with at this time. More than a request for evidence is required before the burden shifts to the examiner to provide support for the subject matter for which Official Notice was taken (*In re Boon*, 169 USPQ 231 (CCPA 1971)). In further explanation, however, account numbers as well as zip code type data are equivalent to identification data which can be used to target, index or route information.

In response to Applicant's argument that Ett is nonanalogous art, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174. In this case, Ett is within the field of endeavor in that identification data is being stored and used within a database environment for using zip codes for mailing purposes or routing purposes. The Ett reference is being used specifically to teach the generation of zip code type data.



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As to the combination of Tillery, Ett and Official Notice not teaching or suggesting 'processing the payment information to produce an eleven digit zip code for the payee' this is nothing more than accessing a data base for account type data which is clearly within the scope of the combination.

Remarks concerning the Tracey reference not teaching updates to database type information is not clear, claims 5, 15, and 20 do not include details as to how the updates or alteration rules for each payee is to be done only that they are. Therefore Tracey teaching a specific method does not negate the use of the reference.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reba I. Elmore, whose telephone number is (703) 308-9706. The examiner can normally be reached on M-TH from 7:30 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by phone fail, the examiner's supervisor, Wil Grant, can be reached at (703) 308-108. Additionally, the fax phone for Art Unit 2306 is (703) 308-9051 or 308-9052.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.



**Reba I. Elmore**

February 28, 2000

Supervisory Patent Examiner  
Art Unit 2700

REBA I. ELMORE  
SUPERVISORY PATENT EXAMINER  
GROUP 2700